

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no. (571) 273-2885, on the date shown below.

Dated: 3/16/09 Signature: Andrea Borden
Andrea Borden

Docket No.: BURF-P02-006
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Fallon et al.

Application No.: 10/081,736

Confirmation No.: 2816

Filed: February 20, 2002

Art Unit: 1649

For: **BIGLYCAN AND RELATED
THERAPEUTICS AND METHODS OF USE**

Examiner: O. N. Chernyshev

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 CFR 1.705(b)

MS Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 1.705(b), Applicants hereby request reconsideration of the patent term adjustment indicated in the Notice of Allowance for the above referenced application. At allowance, the patent was granted a 48 day patent term adjustment. However, as outlined below, Applicants believe that this calculation included errors that deprive Applicants of days of patent term adjustment. Upon review, Applicants believe that the correct patent term adjustment is 249 days at allowance and Applicants respectfully request review and reconsideration.

The following is a summary of the relevant patent term adjustment events as of the date of allowance:

The application was filed on February 20, 2002. However, a first office action was not mailed until May 20, 2004 (PTO delay of 396 days). 37 CFR §1.703(a)(1).

Application No. 10/081,736

Docket No.: BURF-P02-006

A non-final Office Action was issued on September 20, 2004, and a response to the non-final Office Action was filed on January 21, 2005 (Applicant delay of 32 days). 37 CFR §1.704(b).

A final Office Action was issued on April 4, 2005, and an Request for Continued Examination (RCE) was filed on September 9, 2005 (Applicant delay of 67 days). 37 CFR §1.704(b).

A non-final Office Action was issued on November 4, 2005, and a response to the non-final Office Action was filed on April 7, 2006 (Applicant delay of 62 days). 37 CFR §1.704(b).

A final Office Action was issued on June 22, 2006, and a response to the final Office Action was filed on September 25, 2006 (Applicant delay of 3 days). 37 CFR §1.704(b).

A Supplemental Information Disclosure Statement was filed on December 21, 2006 after an RCE was filed on November 22, 2006 (Applicant delay of 29 days). 37 CFR §1.704(b).

A final Office Action was issued on May 24, 2007, and an RCE was filed on October 26, 2007 (Applicant delay of 63 days). 37 CFR §1.704(b).

A non-final Office Action was issued on January 4, 2008, and a response to the non-final Office Action was filed on July 2, 2008 (Applicant delay of 89 days). 37 CFR §1.704(b).

A final Office Action was issued on July 31, 2008, and an RCE was filed on November 3, 2008 (Applicant delay of 3 days). 37 CFR §1.704(b).

A patent was not issued as of February 20, 2005 (i.e., the three-year pendency limit from the filing of the application), but not counting days including and subsequent to the filing date (September 9, 2005) of an RCE (PTO delay of 201 days). 37 CFR §1.702(b)).

Pursuant to *Wyeth v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008), periods of time only "overlap" in the context of calculation of patent term adjustment when the relevant periods of actual delay have at least one day in common. Accordingly, a delay attributable to failure of the USPTO to issue a first action within fourteen months but within the first three years after filing and

Application No. 10/081,736

Docket No.: BURF-P02-006

a delay in patent issuance beyond three years from filing do not overlap.

With regard to the patent term adjustment awarded in the abovementioned application, Applicants assert that the USPTO properly awarded the patent term adjustment due as a result of the delay in issuance of a first action (i.e., 396 days), less the total delay caused by Applicants (348 days). However, Applicants assert that in awarding only 48 days in total, the USPTO apparently erroneously counted the 396 days of USPTO delay in issuing a first action as overlapping with the 201 days of pendency beyond the three year period (but not counting days including and subsequent to the filing date of an RCE (September 9, 2005)). Accordingly, Applicants assert that 201 days of additional patent term, for a total of 249 days, should be awarded in view of *Wyeth v. Dudas* and further in view of the failure to issue a patent within the three year pendency limit.

In sum, Applicants believe that the patent term adjustment should rightfully be increased by an additional 201 days, for a total adjustment of 249 days. Applicants respectfully request reconsideration of the patent term adjustment.

Furthermore, Applicants note for the record and in compliance with 37 CFR 1.705 that (i) this patent is not subject to a terminal disclaimer [37 CFR 1.705(b)(2)(iii)] and (ii) the fee set forth for filing this petition is provided for herewith [37 CFR 1.705(b)(1)].

Application No. 10/081,736

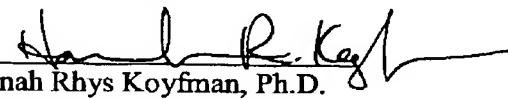
Docket No.: BURF-P02-006

CONCLUSION

Applicants believe that no additional fee is due with this response, other than the petition fee set forth in 37 CFR 1.18(e) and provided for on the accompanying fee transmittal. However, if any additional fee is due, please charge our Deposit Account No. 18-1945, under Order No. **BURF-P02-006** from which the undersigned is authorized to draw.

Dated: 3/16/2009

Respectfully submitted,

By 
Hannah Rhys Koyfinan, Ph.D.

Registration No.: 62,912

ROPES & GRAY LLP

One International Place

Boston, Massachusetts 02110

(617) 951-7000

(617) 951-7050 (Fax)

Attorneys/Agents For Applicant